

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/739,305

REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

Upon entry of this Amendment, claims 1-14 are pending in the application. In response to the Office Action, Applicant respectfully submits the pending claims define patentable subject matter.

Claims 1 and 7 are objected to because of grammatical informalities. By this Amendment, Applicant has amended claims 1 and 7 as suggested by the Examiner. Accordingly, withdrawal of the objection to the claims is requested.

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fleming, III (U.S. Patent No. 6,697,484; hereinafter “Fleming”) in view of DeFazio et al. (U.S. Patent No. 5,940,484; hereinafter “DeFazio”). Applicant respectfully traverses the prior art rejection.

In the Amendment filed January 12, 2005, Applicant argued that independent claims 1 and 7 should be allowable because Fleming, alone or combined with DeFazio, does not teach or suggest “at the agent of the terminal, selecting from among a plurality of external servers at least one external server likely to be able to provide information regarding the identity of the caller”, as recited by claim 1 and similarly recited in claim 7. In response to the January 12 Amendment, the Examiner concedes that Fleming fails to disclose this feature but asserts that “DeFazio discloses caller identification services providing a number of databases (external servers), as one of the databases may not contain the needed information [col. 7: lines 17-26].” The Examiner further asserts that “it would have been obvious to ... modify Fleming to include DeFazio .. [in

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order] to provide a selection of external servers in case one server cannot fulfill the request to identify the caller."

However, Applicant respectfully submits that even if one of ordinary skill in the art would have been motivated to modify the method and/or system of Fleming based on the teachings of DeFazio, the resulting method and/or system would not select at the agent of the terminal, at least one external server likely to be able to provide the information regarding the identity of the caller from among a plurality of external servers, as required by the claims.

Fleming discloses a method and a telephone system wherein a cellular telephone 30 detects an incoming telephone call and determines if the telephone number of the call's originator has previously been stored in a memory 38 of the telephone 30. If the originator's telephone number has not been previously stored, it is stored into the memory 38 of the telephone. In addition, if an alphanumeric identifier associated with the originator's telephone number was received with the originator's telephone number, it is also stored into memory 38. If the alphanumeric identifier was not received, the telephone 30 automatically initiates a call to a remote computer 12 and transmits the telephone number of the originator to the remote computer 12 which includes a database of telephone numbers and alphanumeric identifiers which have been assigned to each telephone number. The computer 12 assigns an alphanumeric identifier to the telephone number and transmits the alphanumeric identifier back to the telephone 30 which stores the alphanumeric identifier in the memory 38 in association with the telephone number.

See Figs. 1-3 of Fleming.

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DeFazio discloses a self-provisioning names database which adds new names to a database for associating names to calling address data in a caller identification with name delivery service each time a new caller places a call to a service subscriber. As shown in Figure 1, a calling party 1 places a call through the public switched telephone network 2 and is ultimately connected to a local switch 3 serving a called subscriber 4 having a telephone and an associated caller identification display unit 4a. A names database 5 is communicably linked to the local switch 3. A national or other names database 6 is communicably linked to the names database 5. When the calling party 1 initiates a call to the called subscriber 4, the local switch (or private branch exchange switch) requests the names database to provide a name associated with the telephone number of the calling party 1. The database 5 queries itself, and if no name is found, initiates a further query or queries to a national database 6 and/or other databases. If a name is found in the database 5 or the national database 6, the name is provided to the called subscriber 4 when the call is connected to the called subscriber 4.

As previously conceded by the Examiner in the January 8, 2004 Office Action (page 2, last paragraph), DeFazio does not disclose “the agent resides in the terminal and includes a program or an application that is stored and activated on the terminal.” Rather, DeFazio simply discloses that when the local switch of the telephone network receives a call to the called subscriber, the local switch requests a predetermined (first) database to provide a name of the calling party. If the first database is unable to provide a name of the calling party, the first database sends one or more requests to other databases to provide a name of the calling party.

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Similarly, the portion of DeFazio cited by the Examiner in support of the rejection (i.e., col. 7, lines 17-26), indicates that if a TCP/IP query, by an SS7 network (K) linked to the local switch (3), of more than one database comes up empty, a back-up list of databases may be contacted (by the local switch or the SS7 network) using a query other than a TCP/IP query, e.g., a dial up connection.

Thus, nowhere does DeFazio teach or suggest that a terminal selects from among a plurality of external servers at least one external server likely to be able to provide information regarding the identity of the caller. Instead, the local switch and/or the SS7 network generates queries which are transmitted to one or more databases.

Accordingly, any modification of the method and/or system of Fleming based on the teachings of DeFazio would simply result in the remote computer 12 or mobile telephone switching office 14 (not the telephone/terminal 30) sending a request or requests to other databases if the remote computer 12 if the remote computer 12 is unable to assign an alphanumeric identifier (name) to the telephone number of the calling party.

Further, in claim 1, the selection step (“selecting from . . .”) precedes the sending step (“sending from . . .”) and even the preparation step (“preparing at . . .”). DeFazio does not make any selection step before preparing and sending its request. *On the contrary*, referring to the passage cited by Examiner (column 7 lines 17-26), further selection of another database is performed after preparing and sending a first request to first database 6 because this further selection *only* happens when first “a first database 6 *fails* to provide a Name for a calling party” (see DeFazio column 7, line 17).

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Accordingly, another difference between the invention of claim 1 and the Examiner's proposed combination of Flemming and DeFazio resides is that in the combined references, the selection step will always happen after the failure of a first request to a first database, never before. This difference is noted in the present application at page 5, second full paragraph: "to begin by determining a server likely to be able to provide the required information, as a preliminary step before retrieving the information".

In view of the above, Applicant respectfully submits that independent claims 1 and 7, as well as dependent claims 2-6 and 8-14, would not have been rendered obvious in view of Fleming and DeFazio because the combined references not teach or suggest all of the features of the claims.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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